



PATENT
Attorney Docket No. 05725.0974-00

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Gilles RUBINSTENN et al.) Group Art Unit: 3629
)
Application No.: 10/024,333) Examiner: Gerardo Araque, Jr.
)
Filed: December 21, 2001) Confirmation No.: 4711
)
For: METHODS AND SYSTEMS FOR)
GENERATING A PROGNOSIS)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on March 26, 2007.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

☒ \$500.00 (Large Entity)

TOTAL FEE DUE:

Appeal Brief Fee \$500.00

Extension Fee (if any) \$120.00


Total Fee Due \$620.00

☒ Enclosed is a check for \$620.00 to cover the above fees.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to Deposit Account No. 06-0916.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 13, 2007

By: 
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PATENT
Customer No. 22,852
Attorney Docket No. 05725.0974-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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Mail Stop Appeal Brief - Patents

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P.O. Box 1450
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Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

This is an appeal to the Board of Patent Appeals and Interferences ("the Board") from the Final Office Action dated December 27, 2006, ("Final Office Action"), rejecting claims 1-48, in the above-referenced patent application. Pursuant to 37 C.F.R. § 41.37, Appellants submit this Appeal Brief and enclose herewith the required fee of \$500.00 under 37 C.F.R. § 41.20(b)(2).

A Notice of Appeal was filed on March 26, 2007. This Appeal Brief is being timely filed along with a petition for a one-month extension of time and fee payment. If any additional fees are required, or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

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I. Real Party In Interest

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office, beginning at Reel 012934, Frame 0114, on May 29, 2002.

II. Related Appeals and Interferences

Appellants, Appellants' legal representative, and Assignee are aware of no other appeals, interferences, or judicial proceedings that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status Of Claims

Claims 1-48 are pending in this application. Claims 1-48, as set forth in the Claims Appendix, were rejected in the Final Office Action and the rejections applied to those claims are at issue in this appeal.

IV. Status Of Amendments

No amendments have been filed subsequent or in response to the Final Office
Action.

V. Summary Of Claimed Subject Matter

A. Independent claim 1

Independent claim 1 recites a method of enabling determination of a prognosis for an external body condition of a subject. The method comprises receiving at least one representation of the subject's external body condition. Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20¹. The method also comprises maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The method further comprises generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the received representation and information contained in the database. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The method further comprises outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

B. Independent claim 31

Independent claim 31 recites a system for enabling determination of prognosis for an external body condition of a subject. The system comprises a memory for receiving at least one representation of the subject's external body condition. Fig. 1,

¹ The designations of reference numerals and identifications of portions of the specification and drawings in this Brief are merely intended to facilitate explaining how the originally-filed application provides exemplary disclosure relating to the claimed subject matter. These designations and references are exemplary and non-exhaustive, and they should not be construed as limiting the claims.

item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises a database for storing information on how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The system further comprises a driver for outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

C. Independent claim 32

Independent claim 32 recites a system for enabling determination of a prognosis for an external body condition of a subject. The system comprises means for receiving at least one representation of the subject's external body condition. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises means for generating at least one prognosis reflecting predicted changes in the external body condition after

use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The system further comprises means for outputting the prognosis to enable the subject to receive the prognosis. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

D. Independent claim 47

Independent claim 47 recites a system for enabling determination of a prognosis for an external body condition of a subject. The system comprises a memory for receiving at least one representative image of the subject's external body condition. Fig. 1; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises a secondary storage storing a mesh frame representative of at least one part of human anatomy. Page 11, lines 4-10. The system further comprises a database containing information on how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C; Fig. 8D; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product. Fig. 2; page 17, line 13 - page 18, line 4. The system further

comprises a driver for outputting the prognosis image to enable the subject to view the prognosis image. Page 19, lines 7-15.

E. Independent claim 48

Independent claim 48 recites a computer-readable medium which stores a set of instructions which when executed performs a method for enabling determination of a prognosis for an external body condition of a subject. The method comprises receiving at least one representation of the subject's external body condition. Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The method comprises maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60, Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The method comprises generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The method comprises outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed:

- A. Claims 31 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,291,889 to Kenet et al. ("Kenet").
- B. Claim 47 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,081,611 to Linford et al. ("Linford").
- C. Claims 1-4, 6-24, 27-29, and 33-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenet in view of the Proactiv website (http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php) ("Proactiv").
- D. Claims 5 and 25-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenet in view of Proactiv and in further view of Linford.

VII. Argument

**A. The Rejection of Claims 31 and 32 Under 35 U.S.C. § 102(b)
Based on Kenet Should Be Reversed**

1. Claim 31

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P § 2131; see *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Kenet discloses "[a]n apparatus and method for facilitating the positioning of a live image with respect to a reference image in which the live and reference images are combined to produce a composite image that is displayed." Kenet, Abstract. Thus, in an "area where temporal comparison of images is important [, such as] in the testing of . . . cosmetics," Kenet teaches "means for controlling and standardizing lighting conditions [to] provide more reliable before and after photographs where changes in the images could more reliably be related to the treatment rather than the image acquisition conditions including camera alignment and lighting changes." Kenet, col. 1, lines 43-53.

Kenet, however, fails to disclose at least “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition” and “a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 31.

In the Final Office Action at page 2, the Examiner asserts that “a database for storing information [is] inherently included in a computer system” without specifically pointing out what portion of Kenet allegedly teaches or suggests a database for storing information. As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (internal citations omitted).

In addition, M.P.E.P. § 2112 states:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (internal citations omitted).

In this case, the Final Office Action fails to provide sufficient evidence from Kenet, or any extrinsic evidence, that makes clear that the subject matter of claim 31 is necessarily present in the reference, or that a database is necessarily present in a computer system. The Final Office Action also fails to present sufficient factual basis

and technical reasoning to demonstrate inherency. For example, a computer system does not necessarily come with a database for storing information. A license for a database, like any other software, must be purchased separately to have the database included in the system. Consequently, the Examiner cannot properly infer that a database is inherently included in a computer system, and that the subject matter of claim 31 is inherently disclosed by Kenet. Moreover, even assuming that a database is inherently included in a computer system, Kenet fails to teach or suggest the existence of any information of how use of at least one beauty product affects evolution of the external body condition.

In addition, Kenet teaches an apparatus and method for aligning images so that more reliable comparison of the images can be made. Thus, Kenet facilitates comparison of the images that are **already captured**, and has nothing to do with generating at least one prognosis reflecting **predicted changes** in an external body condition after use of said at least one beauty product.

In the Final Office Action at page 9, the Examiner asserts that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.” However, the Examiner fails to specifically point out how an apparatus for aligning images for more reliable comparison of the images can be used to generate at least one prognosis reflecting predicted changes in an external body condition. In the Final Office Action at page 2, the Examiner merely points out, from the Kenet reference, a memory for storing and digitizing a previously captured image, and a combiner that combines two digital image signals either linearly or nonlinearly to produce a digital composite image and performs a combining function, taking two images as its input and outputting a single

image. It is not clear how the memory and the combiner disclosed in Kenet are capable of generating at least one prognosis reflecting predicted changes in an external body condition after use of said at least one beauty product. According to the Examiner, any computer system with a processor and a memory would anticipate the claimed invention recited in independent claim 31. Such a view is clearly erroneous because it effectively ignores the express recitations in claim 31.

For at least these reasons, the § 102 rejection of claim 31 based on Kenet should be reversed.

2. *Claim 32*

Independent claim 32 recites “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database.”

In the Final Office Action at page 2, the Examiner asserts that “a database for storing information [is] inherently included in a computer system” and “a processor [for modifying for a representation is] inherently included in a computer system. Even assuming that the Examiner’s assertions were true, it cannot be said that “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition” and “means for generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation

and information contained in the database” are inherently included in a computer system. A computer system by itself does not perform the “maintaining” and “generating” functions recited in independent claim 32, and as the Examiner admits, Kenet fails to explicitly disclose these functions. As explained above with respect to independent claim 31, the Examiner cannot ignore the functions recited. Thus, the § 102 rejection of claim 32 based on Kenet should also be reversed.

B. The Rejection of Claim 47 Under 35 U.S.C. § 102(b) Based on Linford Should Be Reversed

Linford discloses an aesthetic imaging system for use in editing digital images. Linford, Abstract. The aesthetic imaging system includes an imaging program that runs on a computer having a image capture board, a monitor, a video source for providing digital images to be edited by the aesthetic imaging system, and a pen and tablet for use in editing the images. *Id.*

Linford, however, fails to disclose at least “a database containing information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product,” as recited in independent claim 47.

In the Final Office Action at page 2, the Examiner asserts that Linford “discloses a memory for receiving data, secondary storage for storing data, a database containing data, processor for rendering, modifying, and generating an image . . . and driver for outputting an image.” However, nowhere does Linford even mention the term

“database,” and the Examiner has not established that a database is inherently disclosed in Linford. As set forth above with respect to claim 31, a database is not necessarily present in a computer system, and the Final Office Action fails to provide sufficient evidence from Linford, or any extrinsic evidence, that makes clear that a database is necessarily present in a computer system. The Final Office Action also fails to present sufficient factual basis and technical reasoning to demonstrate inherency. Moreover, even assuming that a database is inherently present in a computer system, Linford fails to disclose the existence of any information of how use of at least one beauty product affects evolution of the external body condition.

Linford teaches an aesthetic imaging system for use in editing digital images. In the Final Office Action at page 9, the Examiner asserts that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.” However, the Examiner fails to specifically point out how an aesthetic imaging system for use in editing digital images can be used to generate at least one prognosis reflecting predicted changes in an external body condition. In the Final Office Action at page 2, the Examiner merely points out, from the Linford reference, a processing unit that runs an image program, which includes a freehand draw mode, a curve mode, and an undo mode, and a memory (RAM, ROM, magnetic and storage media) connected to the processing unit. Contrary to the Examiner’s allegations, the processing unit that runs the image program, as described in Linford, and the memory are not disclosed as being capable of generating at least one prognosis reflecting predicted changes in an external body condition after use of said at least one beauty product. According to the Examiner’s strained analysis, any computer system with a processor and a memory

would anticipate the claimed invention recited in independent claim 47. Such a position is clearly erroneous.

For at least these reasons, the § 102 rejection of claim 47 based on Linford should be reversed.

C. The Rejection of Claims 1-4, 6-24, 27-29, and 33-48 Under 35 U.S.C. § 103 Based on Kenet in view of Proactiv Should Be Reversed

The rejection of claims 1-4, 6-24, 27-29, and 33-48 under 35 U.S.C. § 103(a) should be reversed because a case for *prima facie* obviousness has not been established. In particular, *prima facie* obviousness has not been established with respect to claims 1-4, 6-24, 27-29, and 33-48 at least because (1) Kenet and Proactiv, taken alone or in combination, fail to teach or suggest all of the features recited in claims 1-4, 6-24, 27-29, and 33-48; and (2) the Final Office Action fails to provide a proper reason to combine Kenet and Proactiv in a manner resulting in Appellants' claimed invention.

1. *Kenet and Proactiv do not disclose or suggest the subject matter recited in claims 1-4, 6-24, 27-29, and 33-48*

a) *Claims 1-4, 6-24, 27-29, and 48*

Kenet and Proactiv, taken alone or in combination, fail to teach or suggest at least "generating at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product, wherein the generating is based on both . . . received representation [of the external body condition] and information contained in [a] database," as recited in independent claims 1 and 48. In

the Final Office Action at page 3, the Examiner asserts that Kenet discloses the “generating” feature by citing column 1, lines 46-47 and column 3, lines 25-29.

Kenet teaches an apparatus and method for aligning images to improve reliability of comparing the images. Thus, Kenet facilitates comparison of images that are **already captured**, and has nothing to do with generating at least one prognosis reflecting **predicted changes** in an external body condition after use of at least one beauty product.

The portions of Kenet cited by the Examiner describe using “before and after photographs of regions of skin . . . to document the benefits of a treatment.” Kenet, col. 1, lines 45-47. One aspect of the system uses a combiner that multiplies each of the images by a mask function and performs a combining function, “taking two images as its input and outputting a single image.” Kenet, col. 3, lines 25-29. However, this is not a teaching or suggestion of “at least one prognosis reflecting predicted changes,” as recited in claims 1 and 48. Thus, Kenet fails to teach “generating at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product . . . ,” as recited in claims 1 and 48.

Proactiv allegedly discloses information of “how the use of a beauty product affects the evolution of an external body condition . . . in a database.” Even if the allegation were true, Proactiv fails to teach or suggest “generating at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product, wherein the generating is based on both . . . received representation [of the external body condition] and information contained in [a] database,” and thus fails to cure the deficiencies of Kenet.

In the Final Office Action at page 9, the Examiner asserts that “one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references,” and the Examiner cites *In re Keller*, 642 F.2d 413 (CCPA 1981) and *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). This general assertion fails to address the simple fact that neither Kenet, nor Proactiv, nor any combination thereof, teaches or suggests at least the “generating” feature.

Claims 2-4, 6-24, and 27-29 depend from independent claim 1. Thus, for reasons at least similar to the reasons set forth with respect to independent claim 1, Kenet and Proactiv, taken alone or in combination, fail to teach or suggest all of the features recited in claims 2-4, 6-24, and 27-29. Accordingly, the rejection of claims 1-4, 6-24, 27-29, and 48 based on Kenet and Proactiv should be reversed.

b) Claims 33-46

Claims 33-46 depend from independent claim 32. As explained above with respect to the § 102 rejection of claim 32 based on Kenet, Kenet fails to teach “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database.” As explained above with respect to independent claims 1 and 48, Proactiv fails to teach or suggest the “generating” feature, and thus fails to cure the deficiencies of Kenet with respect to claim 32. Consequently, the rejection of claims 33-46, which depend from claim 32, should be reversed.

c) Claim 47

In the Final Office Action at page 3, independent claim 47 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kenet in view of Proactiv. However, the Examiner has no explanation for the basis of the § 103 rejection of claim 47.

Independent claim 47 recites features that are similar to the features recited in independent claims 1 and 48. For at least reasons similar to the reasons set forth with respect to claims 1 and 48, Kenet and Proactiv, taken alone or in combination, fail to teach or suggest every claim element recited in independent claim 47. For example, neither Kenet, nor Proactiv, nor any combination thereof teaches or suggests “a database containing information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product,” as recited in claim 47. Accordingly, the § 103(a) rejection of claim 47 based on Kenet and Proactiv should be reversed.

2. The Final Office Action fails to set forth a legitimate reason for combining Kenet and Proactiv to yield the invention in claims 1-4, 6-24, 27-29, and 33-48

Additionally, the Final Office Action fails to set forth a legitimate reason for modifying Kenet in view of Proactiv. The Examiner has not shown by clear and particular evidence that a skilled artisan considering Kenet and Proactiv, and not having the benefit of Appellants' disclosure, would have modified or combined the references in a manner resulting in the invention defined by claims 1-4, 6-24, 27-29, and 33-48.

In the Final Office Action at page 4, the Examiner alleges that “it would have been obvious to one having ordinary skill in the time of the invention to modify Kenet in view of the teachings of Proactiv to include information on how the use of a beauty product affects the evolution of an external body condition in order to better inform and demonstrate to a user of the products effects.” Also, in the Final Office Action at page 10, the Examiner alleges, without providing any meaningful explanation, that it would have been obvious to one skilled in the art to combine the teachings of Kenet and Proactiv.

These allegations in the Final Office Action are not supported and do not show that a skilled artisan would have modified Kenet as alleged. The Examiner’s alleged reasoning is not clear and particular, and is not supported by any evidence. For example, Kenet is directed to an apparatus and method for spatially positioning images to improve reliability of comparing two images. These two images can be, among many, before and after photographs of a treatment that is actually received. It is not clear why a skilled artisan in image processing and positioning would modify Kenet to include Proactiv, which is a website that provides general descriptions of skin care products.

As M.P.E.P. § 2143.01 makes clear, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). In this case, the Examiner has not shown that Kenet or Proactiv “suggests the desirability” of the alleged modification.

Appellants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of the cited references. Examiners may not pick and choose among isolated disclosures in references to defeat patentability of a claimed invention. Such picking and choosing amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For these additional reasons, Appellants respectfully request that the Board reverse the § 103(a) rejection of claims 1-4, 6-24, 27-29, and 33-48 based on Kenet and Proactiv.

**D. The Rejection of Claims 5 and 25-30 Under 35 U.S.C. § 103(a)
Based on Kenet in view of Proactiv and further in view of
Linford Should be Reversed**

Appellants respectfully submit that the § 103 rejection of claims 5 and 25-30 based on Kenet in view of Proactiv and further in view of Linford should be reversed because the Final Office Action fails to establish a *prima facie* case of obviousness.

1. Kenet, Proactiv, and Linford do not disclose or suggest the subject matter recited in claims 5 and 25-30

As explained above, Kenet and Proactiv, taken alone or in combination, fail to disclose “generating at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product, wherein the generating is based on both . . . received representation [of the external body condition] and information contained in [a] database,” as recited in independent claim 1, from which claims 5 and 25-30 depend.

In the Final Office Action at pages 7-8, the Examiner asserts that Linford discloses "rendering the prognosis on a three-dimensional image[,] generating a mathematical model corresponding to a three-dimensional mesh image[,] and manipulating a patient's image in response to feedback provided by the patient."

Appellants respectfully disagree. However, even assuming these allegations were true, Linford fails to teach or suggest "generating at least one prognosis reflecting predicted changes in [an] external body condition after use of . . . at least one beauty product, wherein the generating is based on both . . . received representation [of the external body condition] and information contained in [a] database," as recited in claim 1, and thus Linford fails to cure the deficiencies of Kenet and Proactiv with respect to claim 1.

For at least these reasons, the § 103(a) rejection of dependent claims 5 and 25-30 based on Kenet, Proactiv, and Linford should be reversed.

2. The Final Office Action fails to set forth a legitimate reason for modifying Kenet in view of Proactiv and further in view of Linford

Additionally, the Final Office Action fails to set forth a legitimate reason for modifying Kenet in view of Proactiv and further in view of Linford. The Examiner has not shown by clear and particular evidence that a skilled artisan considering Kenet, Proactiv, and Linford, and not having the benefit of Appellants' disclosure, would have modified or combined the references in a manner resulting in the invention defined by claims 5 and 25-30.

In the Final Office Action at page 8, the Examiner alleges that "it would have been obvious to one having ordinary skill in the time of the invention to modify the combination of Kenet and Proactiv in view of the teachings of Linford to have a means

of manipulating a patient's image in response to feedback provided by the patient."

Also, in the Final Office Action at page 10, the Examiner alleges that "combining [the teaching of Linford] with the teachings of both Kenet and Proactiv would . . . have been obvious to one skilled in the art in order to provide the patient/customer with a more detailed and informative image of predicted changes of using a beauty product." These allegations in the Final Office Action are not supported and do not show that a skilled artisan would have modified Kenet as alleged.

As M.P.E.P. § 2143.01 makes clear, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (citations omitted). In this case, the Examiner has not shown that Kenet, Proactiv, or Linford "suggests the desirability" of the alleged modification.

Appellants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of the cited references. Examiners may not pick and choose among isolated disclosures in references to defeat patentability of a claimed invention. Such picking and choosing amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For these additional reasons, Appellants respectfully request that the Board reverse the § 103(a) rejection of claims 5 and 25-30 based on Kenet, Proactiv, and Linford.

VIII. Conclusion


For the reasons given above, claims 1-48 are patentable over the cited references. The Board is therefore respectfully requested to reverse the outstanding rejections under 35 U.S.C. § 103(a), so that those pending claims may be allowed.

To the extent any additional extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 13, 2007

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IX. Claims Appendix

1. A method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:
 - receiving at least one representation of the subject's external body condition;
 - maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;
 - generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the received representation and information contained in the database;
 - and
 - outputting the prognosis to enable the subject to receive the prognosis.
2. The method of claim 1, wherein the at least one representation defines the external body condition.
3. The method of claim 1, wherein the at least one representation comprises at least one representative image of the external body condition.
4. The method of claim 1, wherein the prognosis comprises a prognosis image.
5. The method of claim 4, wherein the prognosis image comprises a three-dimension prognosis image.

6. The method of claim 1, further comprising enabling the subject to receive instructions relating to obtaining of the representation.

7. The method of claim 6, wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner.

8. The method of claim 1, further comprising constructing an image based on the representation, wherein said generating of the prognosis comprises comparing the constructed image to the information in the database.

9. The method of claim 3, wherein the wherein the information in the information comprises image morphing information, and wherein said generating of the prognosis comprises morphing the representative image based on the image morphing information.

10. The method of claim 1, wherein the representation is received via a network, and wherein the subject is located at a location remote from a location where the database is maintained.

11. The method of claim 1, wherein the representation is stored in a data storage device, and wherein said receiving of the representation comprises receiving the data storage device.

12. The method of claim 1, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products.

13. The method of claim 12, wherein the outputting further comprises outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis.

14. The method of claim 1, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product.

15. The method of claim 14, wherein the outputting further comprises outputting usage information to enable the subject to be informed about the manner of beauty product usage relating to the information in the database used to generate the prognosis.

16. The method of claim 14, wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, frequency of use of the product, the length of time between each use of the product, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device.

17. The method of claim 1, wherein the beauty product is chosen from skin products, hair products, and nail products.
18. The method of claim 1, wherein the beauty product comprises a skin product chosen from moisturizers, wrinkle removers, and exfoliates.
19. The method of claim 1, wherein the beauty product comprises a hair product chosen from a conditioner and a shampoo.
20. The method of claim 1, further comprising outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis.
21. The method of claim 1, wherein the generating the prognosis comprises comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing.
22. The method of claim 1, wherein the outputting the prognosis comprises transmitting the prognosis via a network.

23. The method of claim 1, wherein the at least one beauty product is selected from a plurality of differing beauty products, and wherein the method further comprises receiving a selection of the at least one beauty product.

24. The method of claim 23, further comprising enabling the subject to make the selection of the at least one beauty product from the plurality of beauty products.

25. The method of claim 1, further comprising rendering the prognosis on a three-dimensional mesh image.

26. The method of claim 25, further comprising generating a mathematical model corresponding to a three-dimensional image resulting from the rendering of the prognosis on the three-dimensional mesh image.

27. The method of claim 3, further comprising enabling modification of the representative image based on an input by the subject.

28. The method of claim 27, wherein the input by the subject further comprises at least one of the addition and removal of wrinkles from the representative image.

29. The method of claim 28, wherein said at least one of the addition and removal of wrinkles comprises modifying at least one parameter associated with a mathematical model corresponding to the image.

30. The method of claim 26, wherein generating at least one prognosis comprises modifying at least one parameter associated with the mathematical model.

31. A system for enabling determination of prognosis for an external body condition of a subject, the system comprising:

- a memory for receiving at least one representation of the subject's external body condition;

- a database for storing information on how use of at least one beauty product affects evolution of the external body condition;

- a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and

- a driver for outputting the prognosis to enable the subject to receive the prognosis.

32. A system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

- means for receiving at least one representation of the subject's external body condition;

means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;

means for generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database; and

means for outputting the prognosis to enable the subject to receive the prognosis.

33. The system of claim 32, further comprising means for enabling the subject to receive instructions relating to obtaining of the representation.

34. The system of claim 33, wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner.

35. The system of claim 32, further comprising means for constructing a representative image, wherein said means for generating the prognosis compares the constructed image to the information in the database.

36. The system of claim 32, wherein the representation comprises at least one representative image of the external body condition, wherein the information in the database comprises image morphing information, wherein said means for generating

the prognosis comprises means for morphing the representative image based on the image morphing information.

37. The system of claim 32, wherein the means for receiving comprises means for receiving the representation image data via a network.

38. The system of claim 32, wherein the representation is stored in a data storage device, and wherein said means for receiving the representation comprises means for receiving the data storage device.

39. The system of claim 32, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products.

40. The system of claim 39, wherein the means for outputting further comprises means for outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis.

41. The system of claim 32, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product.

42. The system of claim 41, wherein the means for outputting further comprises means for outputting usage information to enable the subject to be informed about the manner of beauty product usage relating to the information in the database used to generate the prognosis image.

43. The system of claim 41, wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, the frequency of use of the product, the length of time between each use of the project, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device.

44. The system of claim 32, further comprising means for outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis.

45. The system of claim 32, wherein the means for generating the prognosis comprises means for comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing.

46. The system of claim 32, wherein the means for outputting the prognosis comprises means for transmitting the prognosis via a network.

47. A system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one representative image of the subject's external body condition;

a secondary storage storing a mesh frame representative of at least one part of human anatomy;

a database containing information on how use of at least one beauty product affects evolution of the external body condition;

a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product; and

a driver for outputting the prognosis image to enable the subject to view the prognosis image.

48. A computer-readable medium which stores a set of instructions which when executed performs a method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:

receiving at least one representation of the subject's external body condition;

maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;

generating at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product, wherein the generating is based on both the representation and information contained in the database; and outputting the prognosis to enable the subject to receive the prognosis.

X. Evidence Appendix

None

XI. Related Proceedings Appendix

None